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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/270,151	03/16/99	DEGABLI	A <i>CW</i>

ARIE DEGABLI
550 FRONTAGE RD
SUITE 3605
NORTHFIELD IL 60093

QM32/0911

EXAMINER

PRYOR, S

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

09/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/270,151

Applicant(s)
Degabli

Examiner
Sean Pryor

Group Art Unit
3724



☒ Responsive to communication(s) filed on 26 Jun 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 7-13 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 7-13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed June 26, 2000 has been entered. Applicant has canceled claims 1-6 and has added new claims 7-13.

Claim Objections

2. Claim 10 is objected to because of the following informalities: "an" (line 8) should read --in--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 7-9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation of "may reversibly retain" (cl. 7, line 10) and "may receive" (cl. 9, line 1; & cl. 13, line 1) are indefinite. The use of the term "may" is not a positive recitation and makes the claims unclear.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 7-13, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackie.

Mackie discloses a utility knife comprising: a separable two halve housing (at 14); a retractable blade (18); a tape measure with a ruler and tab in parallel alignment (Fig. 3 at 50, 54); and a hook located within the housing forming an opening with a first side, a second side, and an apex (Fig. 2 at 34, 36) that extends from the bottom of the housing toward the top.

Mackie discloses the claimed invention except for hooks on each side or halve of the housing. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide hooks on each side of the housing, since it has been held that mere duplication of the essential working parts of device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Furthermore, it has been held that the recitation that an element is "adapted to" (cl. 10, lines 4-5 & cl. 11, lines 2, 5) perform a function is not a positive limitation but only require the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

6. The following are comments from the Examiner in response to Applicant's remarks:

Applicant has overcome the objections to the specification and claims cited in the First Action.

Applicant has overcome the 35 USC § 112 rejection cited in the First Action.

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Response to Arguments

7. Applicant's arguments filed June 26, 2000 have been fully considered but they are not persuasive. Applicant argues that the prior art of Mackie requires a hook that is not integrated. It has been held that the term "integral" or "integrated" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973). Furthermore, applicant argues the functional claim language regarding the reversible nature of the hook and that no additional parts or assembly are needed. However, the phrase following the "wherein" (cl. 1, lines 9-12) language has not been given patentable weight because it has been held that the **functional** "wherein" statement does not define any structure and accordingly can not serve to distinguish the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *In re Mason*, 114 USPQ 127 (CCPA 1957).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Pryor whose telephone number is (703) 308-7601. The examiner can normally be reached on Monday through Friday from 7:45AM to 4:45PM. Examiner has every other Friday off (first Friday of the biweek).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.


M. Roshida
Primary Examiner



sp

August 31, 2000